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10/671,893	09/26/2003	Michael J. Tessmer	5035.143	8000

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EXAMINER

MOHANDESI, JILA M

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3728

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/671,893
Filing Date: September 26, 2003
Appellant(s): TESSMER ET AL.

Gavin J. Milczarek-Desai

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 29, 2006 appealing from the Office action mailed May 02, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,451,590

ADELBERG et al.

9-2002

U.S. Patent Publication No. 2002/0169092 to CATLIN et al. published 11/2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexandre Catlin et al. (U.S. Patent Publication No. 2002/0169092) herein after Catlin in view of Adelberg et al. (U.S. Patent No. 6,451,590). Catlin discloses a container for a product for dissolution in a liquid, comprising: a sealed pouch made of a material that is soluble in said liquid; a product contained in a pouch; and a gas contained in the pouch in sufficient quantity to cause the pouch to be resilient at ambient conditions and reduce the compressibility of the pouch. See page 15, paragraphe [0181].

Catlin does not appear to disclose the air to be pressurized. Adelberg '590 discloses that it is desirable to introduce pressurized gas into pouches to afford to the pouch a flexible mechanical resistance to better protect the product held therein. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make provide pressurized gas to the pouch of Catlin as taught by Adelberg '590 to afford to the pouch a flexible mechanical resistance to better protect the product held therein.

With respect to claim 3, see page 8, paragraph [0097] that teaches the pouch being made of polyvinyl alcohols.

With respect to the pressure of the gas, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the gas pressure, since it has been held that where the general conditions of a claim are disclosed in the

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prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Furthermore depending on where the package is made and where it is shipped to and used (i.e. package made in Holland and shipped and used in Denver (U.S.A) will effect the ambient pressure of the air bubble within the claim parameters.

(10) Response to Argument

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellant's argument that the appellants pressurize for at least one reason not disclosed by the prior art, therefore the appellants pressure of 1-2 psig cannot be obvious because one of ordinary skill is unaware of why the appellants are

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pressurizing, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to appellant's argument that the above references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the above references are both directed to a container for packaging and holding a product.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Jila M Mohandesi

Primary Examiner

Art Unit 3728 10/30/06

Conferees:



Mickey Yu

Supervisory patent Examiner

Art unit 3728



Dave Fidei

Primary Examiner

Art Unit 3728